

Notice of Allowability

Application No.

09/890,326

Examiner

Kuo-Liang Peng

Applicant(s)

EKINAKA ET AL.

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 8/11/04 Supplemental Amendment.
2. ☒ The allowed claim(s) is/are 27-52.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 0904.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 7, 2004 has been entered. Claims 1-26 are deleted. Claims 27-52 are added. Furthermore, Applicant's supplemental response together with affidavit filed on August 11, 2004 have been received.

Examiner's Amendment

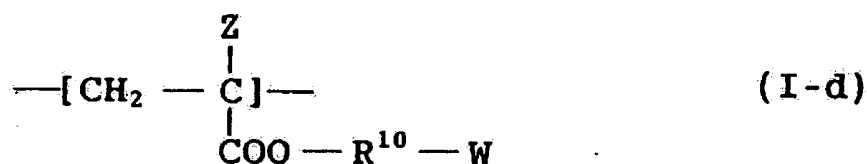
2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

3. Authorization for this examiner's amendment was given in a telephone interview with Mr. Matthew M. Jacob on August 31, 2004.

The application has been amended as follows:

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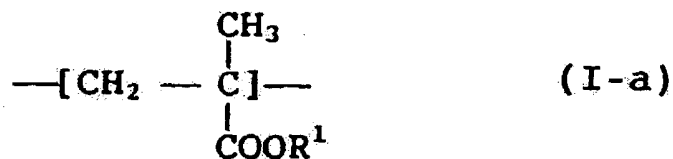
In Claim 29 (line 3), after "formula (I-d)," insert in separate lines the following structure --



--.

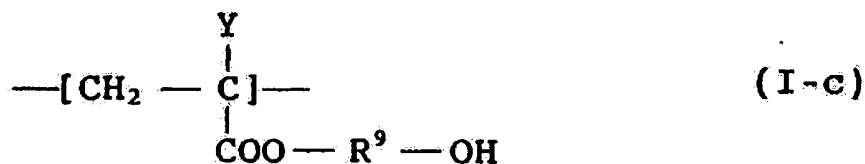
In Claim 30 (line 6), Claim 37 (line 18), Claim 38 (page 9, line 2), Claim 45 (line 6) and Claim 49 (line 6), replace "class" with -- group --.

In Claim 37 (lines 5-7), replace the whole structure (I-c) with --



--.

In Claim 37 (lines 9-11), replace the whole structure (I-a) with --



--.

In Claim 37 (page 7, last line), after "a", insert

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-- solubility of 1.5 g/L or less in a solvent mixture containing 100 parts by weight of isopropanol, 30 parts by weight of methanol and 15 parts by weight of water when measured at 25°C, and --.

In Claim 38 (page 8), delete the last paragraph, i.e., “wherein R⁷ is, R⁸ is an alkyl group having”.

In Claim 41 (line 2), replace “wheal” with -- wheel --.

4. Claim objections in paragraph 3 of the previous Office action (Paper No. 1203) is moot.

5. Claim rejections under 35 USC 102 and 103 in the previous Office Action (Paper No. 1203) is/are removed.

Allowable Subject Matter

6. Claims 27-52 are allowed.

7. The following is an examiner's statement of reasons for allowance:

The present claims are allowable for at least the following reason(s) over the closest reference: Nakayama (JP 59-109528).

In view of Applicants' amendment to specify the presence of methyltrimethoxysilane in an amount of at least 70 wt% in the top coat composition, the present invention is now patentably distinct from the closest reference, Nakayama. Nakayama discloses polycarbonate (page 3, upper left column) coated with a base coat and a top coat (page 3, upper left column). One scenario which is applied in the previous Office action is that the top coat comprises A) 100 parts by weight of a trialkoxysilane of formula (1), B) 56-550 parts by weight of a hydrolyzate of a tetraalkoxysilane of formula (2) wherein c is 0, C) 4 to 334 parts by weight of a colloidal silica. The combined amount of B) and C) is preferably 60 to 567 parts of weight (page 3, upper right column to page 3, lower right column). However, the trialkoxysilane of formula (1) is an epoxy alkoxysilane, not a methyltrialkoxysilane. Therefore, the rejection based on this scenario is moot. The other scenario is that Nakayama teaches that component B) can be methyltrimethoxysilane as also shown in Actual Examples 1, 2, etc. However, in this scenario, the top coat does not contain any tetraalkoxysilane.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

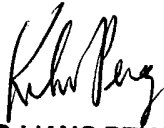
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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
September 2, 2004


KUO-LIANG PENG
PRIMARY EXAMINER

Kuo-Liang Peng
Primary Examiner
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